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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,081	03/15/2005	Daniel Baumgartner	8932-1174-999	5827
51832 JONES DAY 222 EAST 41ST STREET NEW YORK, NY 10017-6702	7590 02/21/2007		EXAMINER SCHILLINGER, ANN M	
			ART UNIT 3738	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/21/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/528,081	BAUMGARTNER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ann Schillinger	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 March 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 March 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 3/15/05.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: Attachment A.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Marnay et al.

(U.S. Pat. No. 6,936,071). Marnay et al. discloses the following of claim 1: an implant, in particular an intervertebral implant, comprising: (A) two articulating parts (4, 10) each having a central axis (see Attachment A), each having a slide surface (12, 25) intersecting the central axes (see Attachment A) and each having an outermost end (2, 3, 24) that can be connected to a bone (col. 5, lines 44-49), wherein: (B) the slide surfaces (see Figure 7) are curved, (C) the slide surfaces are mutually displaceable (col. 5, lines 25-26), and (D) the second slide surface (10) is rotatable about two skewed axes of rotation relative to the first articulating part (see Attachment A), (E) the outermost ends of the articulating parts each comprise a connection element (body portions of elements 2 and 3), wherein: (F) a connecting element is fitted with an oval recess (space where element 4 is located) coaxial with the central axis to receive the outermost end of the adjoining articulating part (see Figure 7); wherein: (G) the recess is fitted with an axially terminal cavity (19) and the outermost end of the adjacent articulating part comprises a widening (26) coaxial with the central axis, said widening being insertable into the cavity (col. 5, lines 11-

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14), and (H) the slide surfaces are saddle-shaped (see Figure 7). It should be noted that the examiner is interpreting the claim language of the “two skewed axes of rotation” to potentially be any axis in space, which the reference element 10 is capable of rotating around. The axes shown in Attachment A are meant merely to illustrate two such axes, and is not intended to limit the interpretation of these axes to those locations alone.

Marnay et al. discloses the following of claim 2: the implant as claimed in claim 1, wherein the slide surfaces each comprise a saddle point (see Attachment A).

Marnay et al. discloses limitations of claims 3-5 because the axes of rotation may be located anywhere element 10 is capable of rotating around, the axes may be drawn with the limitations as described in these claims.

Marnay et al. discloses the following of claim 6: the implant as claimed in claim 1, wherein the slide surfaces (12, 25) each comprise a saddle-point (see Attachment A) and wherein, when the second articulating part (10) is rotated about either one of the axes of rotation (see Attachment A), the second saddle point (saddle point as reference to element 10) moves along an arc of circle concentric with said either one of the axes of rotation (as shown in Figure 7, element 10 will slide along the track created for it by element 4, which is an arc of a circle, and an axis of rotation may be appropriately drawn to be concentric with it).

Marnay et al. discloses the following of claim 7: the implant as claimed in claim 1, wherein, in an initial position, the slide surfaces are congruent at coaxial central axes of the articulating parts (see Attachment A, Figure 7).

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Marnay et al. discloses the following of claim 8: the implant as claimed in claim 1, wherein the connection elements are designed as cover plates (col. 3, lines 64-65; col. 4, lines 9-10) having an axially outermost surface (5, 13) transverse to the central axes (see Attachment A).

Marnay et al. discloses the following of claim 9: the implant as claimed in claim 8, wherein one of the cover plates (2) is integral with the adjoining articulating part (10).

Marnay et al. discloses the following of claim 10: the implant as claimed in claim 8, wherein one of the cover plates (3) is fitted with a guide (27) perpendicular to one of the central axes (see Attachment A) and wherein the adjoining articulating part (4) comprises a rear end (lower portion of element 4) insertable into the guide (see Figure 7).

Marnay et al. discloses the following of claim 11: the implant as claimed in claim 1, wherein one of the articulating parts (4) is rotated about its central axis in order to be assembled to the associated connection element (col. 5, lines 11-14).

Marnay et al. discloses the limitations of claims 12 and 13 in that element 10 would begin at a plane perpendicular to its central axis for it to then be moved and assembled on top of elements 3 and 4.

Marnay et al. discloses the following of claim 14: the implant as claimed in claim 1, wherein one of the articulating parts is made of plastic (col. 5, lines 34-37).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Marnay et al. in view of Ferree et al. (U.S. Pub. No. 2004/0024462). Marnay et al. discloses the invention substantially as claimed, however, Marnay et al. does not disclose using ceramic to make part of the implant. Ferree et al. teaches to use ceramics when making an intervertebral implant in paragraph 0005 for the purpose of decreasing the wear on the implant. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use ceramics when making the implant in order to increase the longevity of the implant by utilizing the ceramics' low wear characteristics.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Schillinger whose telephone number is (571) 272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ann Schillinger  
February 12, 2007

*A. Stewart*  
**ALVIN J. STEWART**  
**PRIMARY EXAMINER**

Attachment A

